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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91203884
Party	Plaintiff Ennis, Inc.
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Attachments	Opp_Resp_to_Motion_to_Compel_070513.pdf(1472529 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Re: Application Serial No. 85/324,443
For the Mark: COLOR WARS
Filed: May 18, 2011
Published in the Official Gazette: January 17, 2012

Ennis, Inc.)	
)	
Opposer)	
)	
v.)	Opposition No. 91203884
)	
Joel L. Beling d/b/a Supa Characters Pty Ltd)	
)	
Applicant)	

Joel L. Beling d/b/a Supa Characters Pty Ltd,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92055374
)	
Ennis, Inc.)	Registration No. 3,372,884
)	Mark: COLORWORX
Registrant.)	

**OPPOSER'S RESPONSE TO
APPLICANT'S MOTION TO COMPEL DISCOVERY RESPONSES**

Opposer, Ennis, Inc. ("Opposer" and/or "Registrant"), by and through its undersigned counsel and pursuant to 37 CFR § 2.127(a) and the Federal Rules of Civil Procedure, hereby files this its Response to Applicant's Motion to Compel Discovery Responses (hereinafter referred to as "Motion to Compel").

I. APPLICANT'S MOTION TO COMPEL IS PROCEDURALLY DEFICIENT

Applicant's Motion to Compel is procedurally deficient because it does not include the statement under 37 C.F.R. § 2.120(e)(1) and TBMP § 523.02 that it made a good faith effort to resolve the issues prior to filing the Motion to Compel on June 20, 2013. Applicant's Motion to Compel should be denied.

TBMP § 523.02 provides "the motion to compel disclosures or discovery must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion and has been unable to reach agreement." *See also* 37 C.F.R. § 2.120(e)(1). A motion to compel that does not comply with the "meet and confer" requirements of 37 C.F.R. § 2.120 should be denied. *See e.g., Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986); *MacMillan Bloedel Ltd v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979).

Applicant's Motion to Compel filed on June 20, 2013 is procedural deficient because (1) all of Applicant's correspondence regarding the discovery in the "Certificate of Conference" occurred in June 2012, approximately twelve months prior to the filing of the Motion to Compel on June 20, 2013,¹ and (2) there is no statement that Applicant made a good faith effort resolve any issues in the Motion to Compel from May 15, 2013, when these proceedings were resumed, until the filing the Motion to Compel on June 20, 2013:

CERTIFICATE OF CONFERENCE

On **June 12, 2012**, Applicant sent Opposer's attorneys an e-mail entitled "Applicant's first good faith attempt to convince opposer to produce documents, answer

¹ The Board suspended these proceedings from July 7, 2012 until May 15, 2013. (Orders of July 17, 2012 and May 15, 2013).

interrogatories and admit or deny questions,” reminding Opposer of its discovery obligations and asking it to provide responses (see Exhibit 2). Opposer refused to comply, stating that its responses were sufficient (see Exhibit 26). Other email correspondence ensued between the parties with applicant continually reminding opposer about its discovery obligations (see Exhibits 3, 5, 6, 8, 9). On **June 19, 2012**, applicant sent opposer’s attorneys an e-mail entitled “Applicant’s second good faith attempt to convince opposer to produce documents, answer interrogatories and admit or deny questions,” reminding opposer of its discovery obligations and asking it to provide responses (see Exhibit 11). Opposer did not reply at all. Further correspondence ensued between the parties (see Exhibits 19-25). On **June 23, 2012**, applicant sent opposer’s attorneys an e-mail entitled “Applicant’s third good faith attempt to convince opposer to produce documents, answer interrogatories and admit or deny questions,” reminding opposer of its discovery obligations and asking it to provide responses. Opposer replied on **27th June 2012** that it would attempt to supplement its discovery responses with further production (see Exhibit 23) but has failed to respond at all with further production.

(Applicant’s Motion to Compel Discovery at 23-24) (emphasis added).

Applicant’s disregard of 37 C.F.R. § 2.120(e)(1) should not be condoned, and its Motion to Compel should be denied in full for failure to comply in full with that rule.

II. APPLICANT FAILED TO MAKE A GOOD FAITH EFFORT TO RESOLVE THE DISCOVERY ISSUES

Applicant failed to make a good faith effort to resolve the discovery issues prior to filing the Motion to Compel on June 20, 2013 as required by 37 C.F.R. § 2.120(e)(1) and TBMP § 523.02. Applicant's Motion to Compel should be denied.

The "meet and confer" requirements of 37 C.F.R. § 2.120 require the moving party or its attorney to make "a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion" prior to filing the motion. A motion to compel that does not comply with the "meet and confer" requirements of 37 C.F.R. § 2.120 should be denied. *See e.g., Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986); *MacMillan Bloedel Ltd v. Arrow-M Corp.*, 203 USPQ 952 (TTAB 1979).

On May 15, 2013, the Board resumed these proceedings. (Order of May 15, 2013). Two weeks later on May 29, 2013, Applicant served 209 Requests for Admission and 10 Interrogatories on Opposer. (Applicant's Fourth Request for Admissions to Opposer; Applicant's Second Set of Interrogatories to Opposer). On May 30, 2013, counsel Scott A. Meyer and Thomas G. Jacks, withdrew as attorneys of record for Ennis, Inc., and were replaced by Daniel J. Chalker and Jessica Flores. (Withdrawal of Counsel and Change in Designation of Lead Counsel for Ennis, Inc.). Within three weeks after Opposer's withdrawal and change in lead counsel, Applicant filed its Motion to Compel on June 20, 2013. Since the resumption of these proceeding on May 15, 2013, Applicant make no effort, much less a good faith effort, to resolve the issues in the Motion to Compel prior to filing the Motion to Compel on June 20, 2013.

Applicant's disregard of 37 C.F.R. § 2.120(e)(1) should not be condoned, and its Motion to Compel should be denied in full for failure to comply in full with that rule.

III. CONCLUSION

Applicant's Motion to Compel is procedurally deficient because it does not include the statement under 37 C.F.R. § 2.120(e)(1) and TBMP § 523.02 that it made a good faith effort to resolve the issues prior to filing the Motion to Compel on June 20, 2013. Moreover, Applicant failed to make a good faith effort to resolve the discovery issues prior to filing the Motion to Compel on June 20, 2013 as required by 37 C.F.R. § 2.120(e)(1) and TBMP § 523.02. Opposer respectfully requests that Applicant's Motion to Compel be denied in its entirety.

Dated: July 5, 2013

Respectfully submitted,

CHALKER FLORES, LLP


By: 

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**ATTORNEYS FOR
OPPOSER/REGISTRANT**

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO COMPEL DISCOVERY RESPONSES was served on all counsel of record, this the 5th of July, 2013, by sending the same via electronically through the Electronic System for Trademark Trials and Appeal ("ESTTA") and electronic mail service.


Daniel J. Chalker